

REMARKS

Claims 1-20 are pending in the application.

Claims 1-20 have been rejected.

Claims 1, 2, 6, 7, 13 and 15 have been amended as set forth herein.

Claims 1-20 remain pending in this application.

Reconsideration of the claims is respectfully requested.

I. CLAIM REJECTIONS -- 35 U.S.C. § 102

Claims 1-4, 6-10 and 12-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,740,178 to *Jacks*, hereinafter (“Jacks”). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131, p. 2100-76 (8th ed., rev. 4, October 2005) (*citing In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. *Id.* (*citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)).

Independent Claims 1 and 6, as amended, require a shadow memory initializer, a shadow memory verifier and that the shadow memory initializer is operable to initialize the shadow

memory by *calculating verification data* for the shadow memory. Similarly, independent Claim 13, as amended, requires *calculating verification data*.

Jacks fails to disclose a shadow memory initializer and shadow memory verifier, as required by Claims 1 and 6. Jacks also fails to disclose *calculating* any verification data as required by Claims 1, 6 and 13. At most, Jacks discloses deriving the data that would be written into EEPROM for each of the locations of the EEPROM and checking whether the derived data is equal to the data already stored in the EEPROM. Accordingly, Jacks fails to anticipate Claims 1, 6 and 13 (and their respective dependents).

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 102 rejection with respect to these claims.

II. CLAIM REJECTIONS -- 35 U.S.C. § 103

Claims 5, 11, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jacks in view of U.S. Patent No. 5,953,352 to *Meyer*, hereinafter (“Meyer”). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-133 (8th ed. rev. 4, October 2005). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.* To establish a *prima facie* case of obviousness, three basic criteria must be met: *Id.* First, there must be some suggestion or motivation, either in the references themselves or in

the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

Claims 5, 11 and 20 ultimately depend from allowable Claims 1, 6 and 13, respectively and are thus also allowable for the reasons stated above. For example, there is no teaching or disclosure within Jacks or Meyer, either alone or in combination, of a shadow memory initializer and shadow memory verifier, as required by Claims 1 and 6 (and ultimately by Claims 5 and 11, respectively). Similarly, there is no teaching or disclosure of *calculating* verification data as required by Claims 1, 6 and 13 (and ultimately required by Claims 5, 11 and 20, respectively). Moreover, there is no motivation or suggestion within Jacks or Meyer to prompt one of ordinary skill to selectively combine and then *seek out* still other elements as required by Claims 5, 11 and 20. Jacks and Meyer therefore fail to render Claims 5, 11 and 20 as obvious.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 103 rejection with respect to these claims.

CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims. If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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